

Application No.: 09/910425

Case No.: 55579US004

Remarks

Claims 1, 3-9, 11-20 will be pending upon entry of the present amendment. Claims 2 and 10 have been canceled and claims 19 and 20 have been added. Claims 1, 7, and 14 have been amended. Claim 1 has been amended to further clarify that the "abrasive composite elements" form a textured three-dimensional abrasive composite. Support for the clarifying amendment can be found, for example, on page 5, lines 4-5. No change in claim scope is intended. Reconsideration of the application as amended is respectfully requested in view of the following comments.

As a preliminary matter, the Office Action has objected claims 6 and 10 for being identical. Claim 10 has been canceled. Therefore, the objection should be withdrawn. The Office Action has also rejected claim 7 under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite for lack of antecedent basis. Claim 7 has been amended and the rejection should be withdrawn.

I. Claims 1, 3, 6-9, 11-12, and 15 are Novel in view of Robinson

Claims 1, 3, 6-9, 11-12, and 15 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Robinson et al. (U.S. 5,733,176). Applicant respectfully traverses this rejection because Robinson does not teach or suggest a fixed abrasive article having a textured three-dimensional abrasive composite with precisely shaped abrasive composite elements as recited in Applicant's claims.

Robinson reports a polishing pad with voids that can be used to contain chemicals. The Office Action alleges that Robinson discloses a textured three-dimensional abrasive composite. Applicant disagrees. Contrary to the Office Action's assertion, the polishing pad reported by Robinson is not textured, but rather, has a flat surface as shown in FIG. 1.

Further, the Office Action alleges that Robinson discloses a fixed abrasive article "comprising three dimensional abrasive composite elements (18, 10)" (Office Action at paragraph 7). Robinson, however, specifies that identifier 18 is used to identify "particles of abrasive" (e.g., column 4, line 20) and identifier 10 is used to identify the "fixed abrasive pad" (e.g., column 4, line 19). It is unclear how Robinson's disclosure of "particles of abrasive" in a

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"fixed abrasive pad" teaches or suggests abrasive composite elements as disclosed by Applicant. As defined by Applicant, an abrasive composite element refers to one of a plurality of shaped bodies that collectively provide a textured, three-dimensional abrasive article (page 5, lines 4-5). Neither the "particles of abrasive" nor the "fixed abrasive pad" disclosed by Robinson form a plurality of shaped bodies that collectively provide a textured, three-dimensional abrasive article. Accordingly, the rejection of claims 1, 3, 6-9, 11-12, and 15 under 35 U.S.C. § 102(b) as allegedly being anticipated by Robinson should be withdrawn.

II. Claims 1, 3-9, and 11-16 are Not Obvious in view of "Applicant's Admitted Prior Art" and Robinson

Claims 1, 3-9, and 11-16 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over "Applicant's Admitted Prior Art" in view of Robinson. Applicant respectfully traverses this rejection because it relies on unspecified references and provides no evidence of record indicating that those of ordinary skill would have been properly motivated to combine the unspecified references with Robinson, much less to combine them in a manner that would have produced Applicants' claimed invention.

The term "Applicant's Admitted Prior Art" is omnibus and not understood by Applicant. The Manual of Patent Examining Procedure specifies that the grounds of rejections should be fully and clearly stated and that omnibus rejections should be avoided. § 707.07(d). Further, the Office Action fails to identify any reason why the skilled artisan would have been motivated to combine the respective teachings of "Applicant's Admitted Prior Art" and Robinson in a way that would have produced a claimed invention. Patent claims cannot be found obvious in view of a combination of references unless there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577 (Fed. Cir. 1984). "A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field." *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000). "In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d 1350, 1357

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(Fed. Cir. 1998). The reasons for the combination must be articulated with specificity. *In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002).

The Office Action provides no reason why one skilled in the art would have combined "Applicant's Admitted Prior Art" and Robinson, much less a reason articulated with specificity as required by case law. Accordingly, the Office Action lacks the required specificity to support a prima facie case of obviousness. The rejection of claims 1, 3-9, and 11-16 under 35 U.S.C. § 103(a) as being allegedly unpatentable over "Applicant's Admitted Prior Art" in view of Robinson should be withdrawn.

III. Claims 1, 3-9, and 11-18 are Not Obvious in view of "Applicant's Admitted Prior Art" and Cheek

Claims 1, 3-9, and 11-18 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over "Applicant's Admitted Prior Art" in view of Cheek (U.S. 5,913,713). Applicant respectfully traverses this rejection because it relies on unspecified references and provides no evidence of record indicating that those of ordinary skill would have been properly motivated to combine the unspecified references with Cheek, much less to combine them in a manner that would have produced Applicants' claimed invention.

As discussed above, the term "Applicant's Admitted Prior Art" is omnibus and not understood by Applicant. Further, the reason for the combination of references to support an obviousness rejection must be articulated with specificity. The Office Action provides no reason why one skilled in the art would have combined "Applicant's Admitted Prior Art" and Cheek, much less a reason articulated with specificity as required by case law. Accordingly, the Office Action lacks the required specificity to support a prima facie case of obviousness. The rejection of claims 1, 3-9, and 11-16 under 35 U.S.C. § 103(a) as being allegedly unpatentable over "Applicant's Admitted Prior Art" in view of Cheek should be withdrawn.

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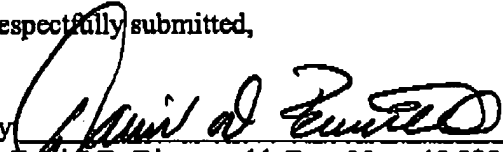
III. Conclusion

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested. The Examiner is invited to contact Applicants' undersigned representative with any questions concerning Applicants' application.

Respectfully submitted,

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Date

By


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